

Response under 37 C.F.R. 1.116

Applicant: Kelli Hodge Kennedy et al.

Serial No.: 09/782,765

Filed: February 13, 2001

Docket No.: 10005680-1

Title: DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT SERVICES MANAGEMENT

REMARKS

The following remarks are made in response to the Final Office Action mailed December 24, 2003, in which claims 1, 3-21, and 23-30 were rejected. Claims 1, 3-21, and 23-30 are presented for reconsideration and allowance.

Examiner Interview

Applicant thanks the Examiner for the courtesies extended to Applicant's representative, Scott Lund, during a telephonic interview conducted on February 18, 2004, during which Applicant's representative and the Examiner discussed the filing date of the present application and the filing date of the Griggs Patent Application, as well as the benefit of earlier filing date and right of priority of the Griggs Patent Application, as outlined below. As a result of the discussions, the Examiner agreed to obtain a copy of Provisional Application No. 60/219,857 and/or a copy of Provisional Application No. 60/233,581, and agreed to make a determination as to whether the subject matter used to make the rejection of claims 1, 3-21, and 23-30 under 35 U.S.C. 102(e) is appropriately supported in the provisional application(s).

IDS/PTO-1449

Applicant notes that Foreign Patent Document "1L" (WO 00/03342) listed on the Form PTO-1449 previously filed on February 13, 2001 was not initialed as being considered by the Examiner. Although it appears as though the Examiner considered the reference on July 27, 2003, Applicant respectfully requests that the box adjacent reference "1L" be initialed by the Examiner and that an initialed and signed copy of the Form PTO-1449 be returned (see MPEP 609, subsection III.C(2)). For the convenience of the Examiner, a copy of the Information Disclosure Statement and Form PTO-1449 previously filed on February 13, 2001 was enclosed with the previous Amendment and Response filed on October 28, 2003.

Claim Rejections under 35 U.S.C. § 102

Claims 1, 3-21, and 23-30 are rejected under 35 U.S.C. 102(e) as being anticipated by the Griggs U.S. Patent Application Publication No. 2002/0029384.

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The filing date of the Griggs Patent Application is July 19, 2001. The filing date of the present application, however, is February 13, 2001. **Thus, the filing date of the present application precedes the filing date of the Griggs Patent Application.**

The "Related U.S. Application Data" of the Griggs Patent Application does identify the Griggs Patent Application as (1) a Non-Provisional of Provisional Application No. 60/219,857, filed on July 20, 2000; and (2) a Non-Provisional of Provisional Application No. 60/233,581, filed on September 19, 2000. Applicant submits, however, that before the Griggs Patent Application can rely on either July 20, 2000 or September 19, 2000 as the earliest effective filing date, **a determination must be made as to whether the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure** (see MPEP 706.02(f)(1) and 706.02(i)).

Thus, Applicant submits that the Examiner must make a determination as to whether the subject matter used to make the rejection of claims 1, 3-21, and 23-30 under 35 U.S.C. 102(c) is appropriately supported in Provisional Application No. 60/219,857, filed on July 20, 2000, and/or Provisional Application No. 60/233,581, filed on September 19, 2000. To date, Applicant has not received any indication that such a determination has been made. In addition, Applicant submits that neither a copy of Provisional Application No. 60/219,857 nor a copy of Provisional Application No. 60/233,581 has been provided in order to evaluate the propriety of such a determination. As such, Applicant respectfully requests that the Examiner provide a copy of Provisional Application No. 60/219,857 and/or a copy of Provisional Application No. 60/233,581, as relied upon for the earlier filing date, and identify where the subject matter used to make the rejection is appropriately supported in the relied upon provisional application(s).

In addition, Applicant notes that before the Griggs Patent Application can rely on the provisional filing date of July 20, 2000 or the provisional filing date of September 19, 2000 as the earliest effective filing date, **the Griggs Patent Application must contain a specific reference to the prior provisional application(s)** (see MPEP 201.11). Applicant notes that while the first paragraph of the Griggs Patent Application does make specific reference in a claim of priority to Provisional Application No. 60/219,857, the first paragraph of the Griggs Patent Application does not make specific reference in a claim of priority to Provisional

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Application No. 60/233,581. Thus, Applicant submits that the Griggs Patent Application is not entitled to the benefit of the earlier-filed Provisional Application No. 60/233,581.

In view of the above, Applicant submits that the Griggs Patent Application does not qualify as a 102(e) reference. Applicant, therefore, respectfully requests that the rejection of claims 1, 3-21, and 23-30 under 35 U.S.C. 102(e) be reconsidered and withdrawn and that claims 1, 3-21, and 23-30 be allowed.

If, however, the Griggs Patent Application does qualify as a 102(e) reference, Applicant respectfully traverses the rejection.

The method of distributing a document of a user of independent claims 1 and 9 includes registering document distribution services of a plurality of document distribution providers, receiving a distribution request for the document from the user, compiling a list of distribution options for the document based on the document distribution services of the document distribution providers, and presenting the list of distribution options for the document to the user. In addition, the system for distributing a document of a user of independent claim 10 includes a memory device configured to have document distribution services of a plurality of document distribution providers stored therein, and a processor adapted to compile a list of distribution options for the document based on the document distribution services of the document distribution providers. In addition, the method of managing document distribution services of a plurality of document distribution providers of independent claims 19 and 26 includes registering the document distribution services of the document distribution providers, presenting the document distribution services to a user having a document, and receiving a distribution selection for the document from the user, wherein the distribution selection specifies at least one document distribution service of the document distribution services. Furthermore, the system for managing document distribution services of independent claim 27 includes a document distribution system controller configured to have the document distribution services registered therewith such that the document distribution system controller is adapted to present the document distribution services to a user having a document and receive a distribution selection for the document from the user, wherein the distribution selection specifies at least one document distribution service of the document distribution services.

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The Examiner contends that the Griggs Patent Application teaches a method of distributing a document of a user including registering document distribution services of a plurality of document distribution providers, receiving a distribution request of the document from the user, compiling a list of distribution options for the document based on the document distribution services of the document distribution providers, and presenting the list of distribution options for the document to the user. The Griggs Patent Application, however, discloses a system for distributing content data, preferably digital video data, to user locations, wherein a system server stores user accounts and generates customized program schedules for the user accounts based on user criteria, including user preferences, such that authorized users access their accounts to modify user criteria and to select program transmissions (Abstract). The system of the Griggs Patent Application utilizes a server unit coupled to at least one content provider such that the server unit provides a central hub for content data distribution and monitors content data availabilities from the content provider and organizes the content data availabilities into customized program schedules in accordance with user codes (paragraph 0025).

Users of the system of the Griggs Patent Application, however, do not have a document in need of distribution. Rather, the users are seeking television programming. In addition, the content providers for the system of the Griggs Patent Application are not providing document distribution services. Rather, the content providers are providing digital video data. The Griggs Patent Application, therefore, does not disclose a method or system for distributing a document of a user as claimed in independent claims 1, 9, and 10, nor a method or system for managing document distribution services as claimed in independent claims 19, 26, and 27.

In view of the above, Applicant submits that independent claims 1, 9, 10, 19, 26, and 27 are patentably distinct from the Griggs Patent Application and, therefore, in a condition for allowance. Furthermore, as dependent claims 3-8 further define patentably distinct claim 1, dependent claims 11-18 further define patentably distinct claim 10, dependent claims 20, 21, and 23-25 further define patentably distinct claim 19, and dependent claims 28-30 further define patentably distinct claim 27, Applicant submits that dependent claims 3-8, 11-18, 20, 21, 23-25, and 28-30 are also in a condition for allowance. Applicant, therefore, respectfully

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requests that the rejection of claims 1, 3-21, and 23-30 under 35 U.S.C. 102(e) be reconsidered and withdrawn and that claims 1, 3-21, and 23-30 be allowed.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1, 3-21, and 23-30 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Response should be directed to either James R. McDaniel at Telephone No. (208) 396-4095, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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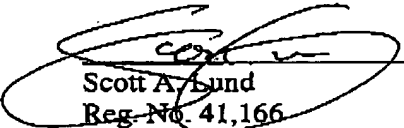
Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on this 17th day of February, 2004.


Name: Scott A. Lund